Appl. No.	:	10/711,954	Confirmation No.: 5953
Applicant:	:	Fonda J. Daniels et al.	
Filed:	:	October 15, 2004	
Title:	:	Method and System to Identify a Previously Visited Universal	
	:	Resource Locator (URL) in Results From a Search	
TC/A.U.	:	2167	
Examiner:	:	Mariela D. Reyes	
	:		
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APPEAL BRIEF IN COMPLIANCE WITH 37 CFR 41.37

In response to the Notice of Panel Decision from Pre-Appeal Brief Review dated as mailed August 3, 2009 this appeal brief is being submitted. The Notice of Appeal was acknowledged as being received on February 9, 2009.

I. Real Party in Interest

The real party in interest is International Business Machines (IBM) Corporation, assignee of record.

II. Related Appeals and Interferences

There are no other appeals or interferences, known to the Appellants, or Appellants' legal representatives, which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

III. Status of Claims

A. Status of All Claims

    1. Claims cancelled: 16 - 33

    2. Claims withdrawn from consideration but not cancelled: None

    3. Claims objected to: None

    4. Claims allowed or confirmed: None

    5. Claims rejected: 1-15 and 34

B. Claims on Appeal

    The claims on appeal are: 1-15 and 34

IV. Status of Amendments

There were no amendments filed after the final office action of October 10, 2008. Applicants chose to proceed directly with this appeal. All previous papers filed by Applicants have been entered.

V. Summary of Claimed Subject Matter

The present invention relates to a method for identifying a previously visited URL in the results from a network search. A URL personal databook collection object is loaded in response to receiving the results of a network search by a search engine. Accordingly, the personal databook collection object is not loaded or accessed until after the network search is performed and the results are received (emphasis added). The URL personal databook collection object comprises URL references that have been previously visited by a user and selectively saved in the URL personal databook collection object by the user. The URL personal databook collection object also comprises a comment associated with each URL reference. The comment may be entered and saved by the user to indicate a reason why each URL reference was stored in the URL personal databook collection object. All search results that satisfy the search term are presented including any URL references that have been previously visited by the user and saved in the URL personal databook collection object as well as URL's which have not been previously visited by the user. Any matches between the search results and any URL object references in

the URL personal databook collection object are identified, such as by highlighting or by other means.

Claims 1, 11, and 34 are independent claims that were rejected under the same art. Claim 1 is an independent method claim to identify a previously visited URL in results from a search. The first element or paragraph of claim 1 is directed to loading a URL personal databook collection object in response to receiving the results of a network search by a search engine. These features are shown in blocks 104 and 106 of Figure 1A and described in paragraph 0013 of the originally filed specification. Also in the first paragraph of claim 1, the URL personal databook collection object comprises URL references that have been previously visited by a user and selectively saved in the URL personal databook collection object by the user. These features are shown in blocks 106, 118 and 120 and are described in paragraphs 0013 and 0018 of the specification. Additionally in the first paragraph of claim 1, the URL personal databook collection object comprises a comment associated with each URL reference that was entered and saved by the user to indicate a reason why each URL reference was stored in the URL personal databook collection object. This feature is shown in blocks 122, 124 and 128 of Figure 1C and described in paragraphs 0019 and 0020 of the specification.

The second element or paragraph of claim 1 is directed to presenting all search results that satisfy the at least one search term including any URL references that have been previously visited by the user and selectively saved in the URL personal databook collection object by the user and including any URL references that satisfy the at least one search term but have not been previously visited by the user and therefore have not been saved in the URL personal databook collection object. These features of claim 1 are shown in block 112 of Figure 1B and elements 202 and 204 in Figure 2 and are described in paragraph 0015 of the specification.

The third element or paragraph of claim 1 is directed to identifying any matches between results from the search and any URL object references of previously visited URLs in the URL personal databook collection object. These features of claim 1 are also shown in block 112 of Figure 1B and elements 204, 206 and 208 in Figure 2 and are described in paragraph 0015 of the specification.

Claim 11 is an independent method claim to identify a previously visited URL in results form a search. The first element or paragraph of claim 11 is directed to entering at least one

search term in a search engine. This feature is shown in block 102 if Figure 1A and described in paragraph 0013 of the specification. The second element of paragraph of claim 11 is directed to comparing the results from a network search by the search engine to any URL object references of previously visited URLs in a URL personal databook collection object loaded after receiving the results of the network search, wherein the URL personal databook collection object comprises URL references that have been previously visited by a user and selectively saved in the URL personal databook collection object by the user; and a comment, associated with each URL reference, entered and saved by the user to indicate a reason why each URL reference was stored in the URL personal databook collection object. These features of claim 11 are shown in blocks 104, 106 and 108 of Figure 1A, blocks 122, 124 and 128 of Figure 1C and described in paragraphs 0013, 0014, 0019 and 0020 of the specification.

The third element or paragraph of claim 11 is directed to visually identifying any matches between the results from the search and any URL object references in the URL personal databook collection object. This feature of claim 11 is shown in block 112 of Figure 1B and reference numerals 204, 206 and 208 of Figure 2 and is described in paragraphs 0015 of the specification.

Claim 34 is an independent method claim to identify a previously visited URL in results from a search. The first element of paragraph of claim 34 is directed to receiving results from a search of websites on a network corresponding to at least one search term, wherein only the at least one search term is entered by a user and only the at least one search term is used by a search engine to perform the search. This feature of claim 34 is shown in block 104 of Figure 1A and is described in paragraph 0013 of the specification.

The second, third and fourth elements or paragraphs of claim 34 are similar to the first, second and third elements or paragraphs of claim 1 and are described above with reference to claim 1.

The fifth element or paragraph of claim 34 is directed to presenting the saved comment associated with any match between results from the search and the URL personal databook collection object, only in response to positioning a computer pointing device on a selected visually identified match in the results from the search. The saved comment is presented as a balloon from the associated match on a page displaying the search results. This feature of claim

34 is shown in block 114 of Figure 1B and reference numeral 210 of Figure 2 and described in paragraph 0016 of the specification.

VI. Grounds of Rejection to be Reviewed on Appeal

Whether claims 1-15 and 34 are unpatentable under 35 U.S.C. §103(a) over Amro et al. (U.S. Patent 6,950,861) in view of Bates et al. (U.S. Patent 5,877,766).

VII. Arguments

Rejection under 35 U.S.C. §103(a) as being obvious over Amro in view of Bates

A. Claims 1-10

Applicants respectfully submit that this rejection under 35 U.S.C. §103 does not follow the M.P.E.P. §706.02(j) which states:

> "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

As discussed below, Applicants respectfully submit that Amro and Bates, whether considered individually or combined, fail to teach or suggest the essential elements needed for a *prima facia* rejection under §103. Claim 1 recites:

> "loading a URL personal databook collection object in response to receiving the results of a network search by a search engine..."

In the Final Office Action dated as mailed October 10, 2008, the examiner cited Column 3, lines 15-19 of Amro in rejecting this feature of claim 1. Column 3, lines 15-19 of Amro recite:

> "Search engine 112 may also receive a search term and an identifier that identifies computer system 110 from computer system 130. In this case, search engine 112 causes

bookmarks 102 on computer system 100 to be accessed and receives identifiers associated with bookmarks 102. Search engine 112 searches the database and websites associated with bookmarks 102 and provides the results of the searches to computer system 130."

Accordingly Amro clearly teaches that the search engine 112 accesses the bookmarks 102 <u>before</u> searching the database and websites associated with the bookmarks 102 and then provides the results of the search *(emphasis added)*. In contrast to Amro, claim 1, as recited above, requires loading a URL personal databook collection object in response to receiving the results of a network search by a search engine. Accordingly, claim 1 requires that the URL personal databook collection object is loaded <u>after receiving the results of the network search</u> *(emphasis added)*. Amro, in contradistinction, teaches that the bookmarks 102 are used by the search engine 112 to perform the database and website searches. Thus, the bookmarks 102 of Amro must be accessed <u>before the search</u> is conducted and Amro does not teach or suggest loading a URL personal databook collection object in response to receiving the results of a network search as provided by the embodiment of the present invention recited in claim 1.

The examiner on page 12 of the Final Office Action under the heading "Response to Arguments" disagrees with Applicants' argument that Amro does not teach or suggest loading a URL personal databook collection object in response to or after the results of a network search as recited in claim 1. The examiner cites Column 4 Lines 2-11 of Amro and Fig. 4 elements 412-418 of Amro. Column 3 beginning at line 65 and continuing in Column 4, Lines 1-11 of Amro recite:

"FIG. 4b is a flowchart illustrating an embodiment of a method for searching websites associated with bookmarks from the perspective of a search engine. A search term and one or more identifiers associated with one or more bookmarks are received as indicated in step 412. One identifier may be received for each of a user's bookmarks. In one specific embodiment, an identifier is an address of a website. A database is searched using the search term as indicated in step 414. It may be noted that the database may be directly associated with the search engine or may be accessed remotely. Websites associated with the bookmarks are searched using the search term as indicated in step 416. Results of the search are provided to a user as indicated in step 418."

This section of Amro and Figure 4b clearly teach that Websites associated with bookmarks are searched using a search term associated with the bookmarks as indicated in steps 412 and 416 of

Figure 4b of Amro. Applicants respectfully submit that Websites associated with bookmarks and search terms from the bookmarks cannot be searched unless the bookmarks are first accessed prior to the search in order to do the search.

Additionally, claim 1 recites:

"wherein the URL personal databook collection object comprises URL references that have been previously visited by a user and selectively saved in the URL personal databook collection object by the user; and a comment, associated with each URL reference, entered and saved by the user to indicate a reason why each URL reference was stored in the URL personal databook collection object..."

Applicants respectfully submit that the URL personal databook collection object of the embodiments of the present invention are distinguishable from the bookmarks as commonly known in the computing arts and as used by Amro. Bookmarks are short cuts or direct links to Websites whereas the personal databook collection of the embodiments of the present invention is used as an aid to help a user identify URLs in search results that have been previously visited and to recall why a particular URL was previously visited. There is not teaching or suggestion in the Amro or Bates of these features of the present invention as recited in claim 1.

Bates was cited in the Final Office Action for teaching a user being able to enter a comment about a document which includes the description of the document (Column 25, lines 38 – 40 of Bates cited in the Final Office Action). Applicants respectfully submit that Bates also does not teach or suggest loading a URL personal databook collection object after receiving the results of a search and Bates adds nothing to the teachings of Amro so as to render claim 1 unpatentable as discussed above.

For all of the reasons discussed above, Applicants respectfully submit that claim 1 is patentably distinguishable over Amro and Bates and the rejection of claim 1 is respectfully submitted to be clear error.

Regarding the rejection of claims 2-10 under 35 U.S.C. §103(a) as being obvious over Amro in view of Bates, these claims depend either directly or indirectly from independent claim 1. Because of this dependency, claims 2-10 include all of the features of claim 1. Therefore,

claims 2-10 are also submitted to be patentably distinguishable over Amro and Bates and allowance of claims 2-10 is respectfully requested.

B. Claims 11-15 and 34

Applicants respectfully submit that independent claim 11 recites similar features to claim 1 that are patentably distinguishable over Amro in view of Bates, whether considered individually or combined. Claim 11 recites:

> "comparing the results from a network search by the search engine to any URL object references of previously visited URLs in a URL personal databook collection object loaded after receiving the results of the network search..." *(emphasis added).*

As previously discussed, Amro teaches that the bookmarks 102 are used in conducting the search and thus are required to be accessed by Amro before any network search. Applicants respectfully submit that neither Amro nor Bates teach or suggest that the URL personal databook collection object is loaded after receiving the results of the network search as recited in claim 11. Accordingly, independent claim 11 is respectfully submitted to be patentably distinct over Amro and Bates, and reconsideration and withdrawal of the §103 rejection of claim 11 is respectfully requested.

Claims 12-15 depend either directly or indirectly from independent claim 11. Because of these dependencies, claims 12-15 include all of the features of independent claim 11. Therefore, claims 12-15 are also submitted to be patentable over Amro and Bates and allowance of these claims is respectfully requested.

Independent claim 34 recites similar features to claims 1 and 11. Accordingly, claim 34 is also submitted to be patentable over Amro and Bates for the same reasons as discussed with respect to claims 1 and 11. Reconsideration and withdrawal of the §103 rejection of claim 34 is respectfully solicited.

Conclusion

For the reasons discussed above, Applicants respectfully submit that the rejections standing in this application are improper. The Examiner has failed to establish a *prima fascia* case of obviousness under 35 U.S.C. §103(a) with respect to claims 1-15 and 34 over the cited documents. Therefore, Applicants respectfully submit that claims 1-15 and 34 are in condition for allowance. Reversal of the rejection of claims 1-15 and 34 is respectfully requested.

Respectfully submitted,

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VIII. Claims Appendix

1.   (Previously Presented) A method to identify a previously visited URL in results from a search, comprising:

loading a URL personal databook collection object in response to receiving the results of a network search by a search engine, wherein the URL personal databook collection object comprises URL references that have been previously visited by a user and selectively saved in the URL personal databook collection object by the user; and a comment, associated with each URL reference, entered and saved by the user to indicate a reason why each URL reference was stored in the URL personal databook collection object;

presenting all search results that satisfy the at least one search term including any URL references that have been previously visited by the user and selectively saved in the URL personal databook collection object by the user and including any URL references that satisfy the at least one search term but have not been previously visited by the user and therefore have not been saved in the URL personal databook collection object; and

identifying any matches between results from the search and any URL object references of previously visited URLs in the URL personal databook collection object.

2.   (Original) The method of claim 1, further comprising comparing the results from the search to any URL object references in the URL personal databook collection object to identify any matches.

3.   (Previously Presented) The method of claim 1, further comprising visually identifying any matches in the results from the search.

4.   (Original) The method of claim 3, further comprising visually identifying any matches by at least one of a predetermined icon, a predetermined text font and highlighting.

5.   (Previously Presented) The method of claim 3, further comprising presenting the saved comment associated with any match only in response to positioning a computer pointing device on a selected visually identified match in the results from the search, wherein the saved comment is presented as a balloon from the associated match on a page displaying the search results.

6.   (Previously Presented) The method of claim 1, further comprising selecting any results from the search containing content of interest for future reference.

7.   (Previously Presented) The method of claim 6, further comprising storing only search results selected by the user in the URL personal databook collection object.

8.   (Previously Presented) The method of claim 7, wherein storing the selected search results comprises storing the URL reference.

9.   (Original) The method of claim 8, further comprising storing the URL reference as a serialized object.

10.   (Previously Presented) The method of claim 7, further comprising storing any other comments in association with the stored search results.

11.   (Previously Amended) A method to identify a previously visited URL in results from a search, comprising:

entering at least one search term in a search engine;

comparing the results from a network search by the search engine to any URL object references of previously visited URLs in a URL personal databook collection object loaded after receiving the results of the network search, wherein the URL personal databook collection object comprises URL references that have been previously visited by a user and selectively saved in the URL personal databook collection object by the user; and a comment, associated with each URL

reference, entered and saved by the user to indicate a reason why each URL reference was stored in the URL personal databook collection object; and

visually identifying any matches between the results from the search and any URL object references in the URL personal databook collection object.

12.   (Original) The method of claim 11, further comprising loading the URL personal databook collection object in response to presenting the results from the search.

13.   (Previously Presented) The method of claim 11, further comprising presenting any saved or captured comments associated with any matches in response to positioning a computer pointing device on a selected visually identified match in the results from the search, wherein the saved or captured comments are presented on a page displaying the search results.

14.   (Original) The method of claim 11, further comprising:

selecting any results from the search containing content of interest for future reference in response to no matches; and

storing any selected search results in the URL personal databook collection object.

15.   (Original) The method of claim 14, further comprising:

presenting a dialogue box to enter comments related to any stored search results; and

storing any comments in association with the stored search results.

16.-33. Cancelled.

34.   (Previously Presented) A method to identify a previously visited URL in results from a search, comprising:

receiving results from a search of websites on a network corresponding to at least one search term, wherein only the at least one search term is entered by a user and only the at least one search term is used by a search engine to perform the search;

loading a URL personal databook collection object only after receiving the results of the network search by the search engine, wherein the URL personal databook collection object comprises URL references that have been previously visited by a user and selectively saved in the URL personal databook collection object by the user; and a comment, associated with each URL reference, entered and saved by the user to indicate a reason why each URL reference was stored in the URL personal databook collection object;

presenting all search results that satisfy the at least one search term including any URL references that have been previously visited by the user and selectively saved in the URL personal databook collection object by the user and including any URL references that satisfy the at least one search term but have not been previously visited by the user and therefore have not been saved in the URL personal databook collection object;

identifying any matches between results from the search and any URL object references of previously visited URLs in the URL personal databook collection object; and

presenting the saved comment associated with any match only in response to positioning a computer pointing device on a selected visually identified match in the results from the search, wherein the saved comment is presented as a balloon from the associated match on a page displaying the search results.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.